



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,436	05/17/1999	DAVID S. SPRINGER	M-7260US	3911

24251 7590 12/06/2001

SKJERVEN MORRILL MACPHERSON LLP
25 METRO DRIVE
SUITE 700
SAN JOSE, CA 95110

EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

2162

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/313,436

Applicant(s)

SPRINGER ET AL.

Examiner

Khanh H. Le

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: ____

Non-Final Action

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al., US 5740549, and further in view of other well-known business and computer methods.

Claim 1.

Reilly discloses

A method of tracking information provided to a computer system from a server, the method comprising:

providing an identifier identifying the computer system (Fig 4 and associated text especially item 212, 213) ;

providing at least one database associating the identifier with information specific to a computer user associated with the computer system (Fig 4 and associated text, especially items 216, 214);

transmitting the identifier to the server, the server affiliated with the at least one database (Figs 11 and 12 and associated text; col 14 l. 17 –col 16 l. 35; Fig 4 and associated text especially items 212, 213;);

transmitting the information to the computer system that is specific to the identifier (Figs 11 and 12 and associated text; col 14 l. 17 –col 16 l. 35; Fig 4 and associated text especially items 212, 213;);

Art Unit: 2162

and logging the transmittal of the identifier in one of the at least one database. (Fig 2 and associated text especially item 210; Fig 4 and associated text especially item 218). (Further, see generally Wexler, US 5960409; Graber et al., US 5712979 for tracking techniques)

Claims 10 and 17 essentially parallel claim 1 in computer system and system formats respectively and are rejected on the same basis.

As for claims 2-9, the method of claim 1 is disclosed as above-discussed.

As for claims 11-16, the method of claim 10 is disclosed as above-discussed.

As for claims 18-24, the method of claim 17 is disclosed as above-discussed.

Claim 2. The method of Claim 1 wherein the logging the transmitting of the identifier further includes: incrementing a counter associated with the identifier. (Fig 2 and associated text especially item 210; Fig 4 and associated text especially item 218);

Claims 14 and 18 essentially parallel claim 2 in computer system and system formats respectively and are rejected on the same basis.

Claim 3. The method of Claim 1 further comprising:
providing that the information transmitted to the computer system includes at least one of advertisements, informational data, advertisements specific to the computer user, and informational data specific to the computer user.
(Figs 11 and 12 and associated text;)

Claim 19 essentially parallel claim 3 in system format and is rejected on the same basis.

Claim 4. Reilly further providing that the server is a server hosting advertisements and informational data. (Figs 11 and 12 and associated text;)

Claim 20 essentially parallels claim 4 in system format and is rejected on the same basis.

Claim 6. The method of Claim 1 wherein the transmitting the identifier includes: requesting access to the server by the computer user via the worldwide web; and transmitting the identifier when the computer user requests access from the server.
Fig 1 and 2 and associated text)

Claims 12 and 22 essentially parallel claim 6 in computer system and system formats respectively and are rejected on the same basis.

Claim 8.

The method of Claim 1 wherein the identifier is one of a system code, system code stored in nonvolatile memory, a unique ID from a microprocessor, a user ID from a peripheral device and a unique identifier stored on a hard drive.

Art Unit: 2162

It is well-known that the identifier can be one of those above claimed. One skilled in the arts would have known to use one of those to apply to the Reilly's system to implement it.

Claims 16 and 24 essentially parallel claim 8 in computer system and system formats respectively and are rejected on the same basis

As to claims 5, 7, 9 Reilly does not specifically disclose the dependent claimed limitations but the business and computer methods contained therein are well-known.

Claim 5. The method of Claim 1 further comprising: providing an application program, the application program querying the computer user as to information specific to the computer user ;if the computer system does not contain a preexisting identifier associated with the at least one database, querying the computer user as to information specific to the computer user; and storing the information in one of the at least one database.

Reilly does not explicitly discloses such application program but implicitly does. One skilled in the arts would have known to use the above-claimed steps as they are logical steps to implement the Reilly's disclosure of identifying the user, the user ' s system and the user's profile for customized delivery of news and other information system.

Claims 11 and 21 essentially parallel claim 5 in computer system and system formats respectively and are rejected on the same basis.

Claim 7. The method of Claim 1 further comprising: when the server receives an identifier, checking the at least one database for the identifier; if the identifier is not found, querying the computer user as to whether the computer user desires to participate in receiving the information from the server; if the computer user desires to participate, building one of the at least one databases that associates the identifier with the computer user; if the identifier is found in the at least one database, searching for matching information unique for the identifier and for the computer user; if matching information is found, transmitting the information unique for the identifier and for the computer user to the computer user from the server; if no matching information is found, transmitting one of generic information and no information; and logging the transmittal of the identifier in one of the at least one database.
(see Reilly, Fig 11s and 12 and associated text).

Further, Reilly does not explicitly disclose such application program but the claimed methods steps are well-known in the arts. One skilled in the arts would have known to use the above-claimed steps as they are logical steps to implement the Reilly's disclosure of identifying the user, the user ' s system and the user's profile for customized delivery of news and other information system. Further the claimed steps of initiating a new user would have been obvious to one skilled in the arts given the knowledge in the arts.

Claim 9.

Art Unit: 2162

The method of Claim 1 wherein the information unique to the computer user includes one of incentives, bonuses and discounts on a plurality of goods.

Reilly does not specifically disclose such but they are usually well-known parts of advertisements (disclosed by Reilly, Fig 1, item 138 and associated text) thus one skilled in the arts would have known to combine them with Reilly's disclosure to provide customized incentives, (also, e.g., in affinity schemes) which are a well-known business methods.

Claims 13 and 23 .

Claims 13 and 23 essentially parallel claim 9 (also claim 3) in computer system and system formats respectively and are rejected on the same basis. (Claims 13 and 20 recite "at least one of advertisements, informational data, advertisements specific to the computer user, and informational data specific to the computer user").

Claim 15.

The computer system of Claim 10 wherein the database is affiliated with an advertisement broker that is also affiliated with the server, the advertisement broker receiving the identifier and logging the transmittal of the identifier in a database to track the transmittal of information specific to the computer user.

Reilly does not specifically disclose an advertisement broker that is also affiliated with the server however such ads brokers/server affiliation is well-known in the arts (see e.g. Dedrich, US 5752238). One skilled in the arts would have known to combine the Reilly's and Dedrich disclosures to extend the reach of the Reilly's system to third parties advertising systems.

Conclusion

3. Prior art made of record (see all cited above) and not relied upon is considered pertinent to applicant's disclosure.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is (703) 305-0571. The examiner is on flexible schedule and can normally be reached on Tuesday-Thursday from 9:00 AM - 6:30 PM. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469.

Application/Control Number: 09/313,436

Page 6

Art Unit: 2162

The Official Fax Numbers for TC-2100 are:

After-final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

KHL

December 3, 2001

Steve Gravini

**STEPHEN GRAVINI
PRIMARY EXAMINER**